Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES L. VINEYARDS, JR. and JAMES A. MCKEETH

Appeal No. 2003-0766
Application No. 09/266,325[1]

HEARD: OCTOBER 9, 2003

Before HAIRSTON, DIXON and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1, 3-9 and 11-20. The Examiner has objected to claims 2 and 10 and has indicated their allowability if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

We reverse.

[1] Application for patent filed March 11, 1999.

BACKGROUND

Appellants' invention is directed to a method and apparatus for specifying an operating system during a current computing session such that upon reboot, the computer will boot up into the specified operating system. A computerized user interface allows a user to select a desired operating system which will load upon restarting of the computer (specification, page 4).

Representative independent claim 1 is reproduced below:

1. A computerized user interface for assisting a computer user in selecting an operating system for use on a computer comprising:

a computer for storing, displaying, and processing information;

computer program code running on said computer, the computer program code operating in a current computing session and implementing in the computer the steps of:

providing an interactive menu on a display, said menu comprising a list of operating systems available to run on said computer;

providing an activatible control mechanism for selecting one of the operating systems displayed on said menu; and

setting a default operating system for a load utility installed on said computer to an operating system selected with the activatible control.

The Examiner relies on the following references in rejecting the claims:

Niwa et al. (Niwa)	5,671,366	Sep. 23, 1997
Stein	5,684,952	Nov. 4, 1997
Nguyen et al. (Nguyen)	5,887,163	Mar. 23, 1999 (filed Apr. 4, 1997)
Lister et al. (Lister)	5,966,540	Oct. 12, 1999 (filed Jul. 23, 1997)
Shoji et al. (Shoji)	6,031,527	Feb. 29, 2000 (filed Jul. 12, 1996)
Dougherty et al. (Dougherty)	6,076,734	Jun. 20, 2000 (filed Oct. 10, 1997)
Dean et al. (Dean)	6,202,206	Mar. 13, 2001 (filed May 14, 1998)

Claims 1, 5, 9, 16 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Niwa.

Claims 3, 4, 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Niwa and Shoji.

Claims 6, 7, 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Niwa and Lister.

Claims 8 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Niwa and Nguyen.

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Niwa and Dean.

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Niwa, Dean and Stein.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Niwa, Dean and Dougherty.

We make reference to the answer (Paper No. 14, mailed September 11, 2002) for the Examiner's reasoning, and to the appeal brief (Paper No. 13, filed August 15, 2002) and the reply brief (Paper No. 15, filed November 19, 2002) for Appellants' arguments thereagainst.

OPINION

With respect to the 35 U.S.C. § 102 rejection of claims 1, 5, 9, 16 and 20, Appellants point out that Niwa does not describe using the selected operating system by default for subsequent sessions (brief, page 5). Appellants further assert that once the user selects an operating system during the start up, the operating system is automatically placed at the top of the list of the operating systems and is retained only during that operating session (brief, page 5; reply brief, page 2). Additionally, Appellants argue that Niwa's default operating system is always the same and is only changed when a user selects an operating system during the boot operation (reply brief, page 2).

In response to Appellants' arguments, the Examiner argues that Niwa uses the selected operating system by default for the subsequent session (answer, page 10). The Examiner further asserts that Niwa selects the operating system possessed by the first electronic device as the default operating system and therefore, in a subsequent session, the default operating system is determined by the operating system of that device (answer, page 11).

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

After reviewing Niwa, we agree with Appellants' assertion (brief, page 6; reply brief, page 3) that Niwa's selection of the default operating system is not based on the user selection via an interactive menu, but by the operating system that resides on the first electronic device. Niwa relates to operating system optimization in expanded systems wherein a notebook is connected

to a desktop PC via a docking station (abstract). The operating systems are displayed as a list of bootable operating systems and selected by the user to be used during start up (col. 3, lines 5-10). However, the displayed list of the operating systems is presented such that the operating system of the first electronic device attached to the PC is selected by default (col. 3, lines 11-17). Therefore, instead of the claimed setting the default operating system based on user selection, Niwa provides for a display of the operating systems such that the operating system that the user has selected for a session starts up the computer only during that session and the operating system of the first electronic device, which is always set as the default operating system, starts up the subsequent sessions when there is no user selection.

As discussed above, what the Examiner characterizes in Kondo as the default operating system (answer, page 11), is actually the operating system of the first electronic device that is always there and is not selected by a user. In fact, in the subsequent start up, Niwa uses the preset default operating system, not the one the user selected in the previous computer session (col. 12, lines 1-7). Thus, Niwa does not anticipate claim 1, nor the other independent claims which recite setting an

operating system selected by the user as the default operating system. Accordingly, the 35 U.S.C. § 102 rejections of claims 1, 5, 9, 16 and 20 over Niwa cannot be sustained.

Turning to the 35 U.S.C. § 103 rejections of the claims, the Examiner, further relies on Shoji for restarting by the user, on Lister for uninstall/reinstall of the program, on Nguyen for partitioning of the hard drive and on Dean for selection mechanism. Additionally, Dougherty is relied on for teaching the selection of boot icon while Stein discloses display regions for user interactive controls. We further note that claim 17, the only other independent claim, also recites that the selected operating system is loaded upon subsequent computer start up. By relying on these references, the Examiner has not provided any additional evidence to overcome the deficiencies of Niwa as discussed above with respect to the rejection of claims 1, 5, 9, 16 and 20, and therefore, has failed to establish a prima facie case of obviousness. Accordingly, we do not sustain the 35 U.S.C. § 103 rejections of any of claims 3, 4, 6-8, 11-15 and 17-19 over Niwa in various combinations with Shoji, Lister, Nguyen, Dean, Dougherty and Stein.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1, 5, 9, 16 and 20 under 35 U.S.C. § 102 and rejecting claims 3, 4, 6-8, 11-15 and 17-19 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
JOSEPH L. DIXON Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MAHSHID D. SAADAT Administrative Patent Judge	)	

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